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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,042	07/19/2001	Kenichiro Matsuura	B588-021	8469
26272 7590 05/09/2007 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER PRIETO, BEATRIZ	
			ART UNIT 2142	PAPER NUMBER
			MAIL DATE 05/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/909,042

Applicant(s)

MATSUURA ET AL.

Examiner

Prieto B.

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2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 117-124 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 117-124 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



***DETAILED ACTION***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/05/07 has been entered.

2. Scope of claimed invention of claims 117-118. Regarding the apparatus claimed on claims 117-118 comprising: An information providing apparatus, comprising; a management, reception, first determining, second determining, first generation, second generation and sending units, with respected intended functionalities preceding the "adapted to" clause. It is respectfully noted that the limitations of the claim pertaining to: manage settings, receive, determine, and sending, appear to be intended used. As such, these limitations do not further limit the apparatus in its *structure or functionality performed by the apparatus*. Specifically, it is noted that product claims are claims that are directed to either machines, manufactures or compositions of matter. For products, the claim limitations will define discrete physical structures or materials. (see MPEP 2106 II(C) and 2111.04). The apparatus claimed on claims 117-118 has further been evaluated with respect to its characteristics and its practical utility. Product claims may comprise a combination of devices that constitute the machine and may also include one or more steps of the functions that performed by the machine (e.g., R.A.C.C. Indus. v. Stun-Tech, Inc., 178 F.3d 1309 (Fed. Cir. 1998)(unpublished) (see Patent Subject matter Eligibility MPEP §2106). As such, the above-mentioned limitations do not further limit the apparatus in its *structure or functionality performed by the apparatus*. In accordance with the MPEP, the subject matter of a properly construed claim is defined by the terms that limit its scope. It is *this* subject matter that must be examined. Language that suggests or makes optional but does *not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation*. Examples of language that may raise a question as to the limiting effect of

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the language in a claim: (A) statements of intended use or field of use, (B) “*adapted to*” or “*adapted for*” clauses. See also MPEP § Patent Subject matter Eligibility.

2106 and §2111.04.

***Claim Rejection under 35 U.S.C. §101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 119-124 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101, namely, process, machine, manufacture, composition of matter or improvements thereof.

In this case, for example, the claim 119 appears to be method claim stored (according to claim 121) on a computer readable medium. However, the written disclosure of the invention does not provide clear support or antecedent basis (such as explicit and deliberate definitions or intrinsic evidence such as examples or preferred embodiments) for the term (i.e. computer readable medium) as used in the claim(s) (see 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and §1302.01). In absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003). The specification does provide evidence in the form of exemplary embodiments to what does the term “storage medium” mean.

As such, the claimed term “*computer readable media*” will take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. The term *machine-readable media* means a data media/medium that is machine readable. The term media which is the plural of medium, is (a) a means of communication, (b) material on which information can be stored or transported (see IEEE 100 “The Authoritative Dictionary of IEEE Standards Terms 7<sup>th</sup> Ed., 2000, p. 650 and 682-683 on PTO-892).

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When descriptive material is recorded on some computer-readable medium, in a computer or on an *electromagnetic carrier signal*, it is not statutory since no requisite functionality is present to satisfy the practical application requirement (see Computer-related non-statutory subject matter MPEP §2106.01). It is noted that a computer readable medium having instructions thereon which when executed perform the steps of: a useful method would normally be considered statutory *unless* the meaning thereof includes *intangible media* such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. The meaning thereof also includes tangible media such as paper, which though seemingly a “manufacture” or “machine” should be rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967) (see MPEP 706.03(a) (A) Printed Matter). The term storage medium as exemplified in the specification seems to be limited to include tangible mediums [see par 0142-0146].

5. Claim 119 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

***Claim Rejection under 35 USC 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 117-118 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, the scope of claimed invention has been evaluated. Regarding the apparatus claimed on claims 117-118 comprising: An information providing apparatus, comprising; a management, reception, first determining, second determining, first generation, second generation and sending units, with respected intended functionalities preceding the “adapted to” clause. It is respectfully noted that the limitations of the claim

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pertaining to: manage settings, receive, determine, and sending, appear to be intended used. As such, these limitations do not further limit the apparatus in its *structure or functionality performed by the apparatus*. Specifically, it is noted that product claims are claims that are directed to either machines, manufactures or compositions of matter. For products, the claim limitations will define discrete physical structures or materials. (see MPEP 2106 II(C) and 2111.04). The apparatus claimed on claims 117-118 has further been evaluated with respect to its characteristics and its practical utility. Product claims may comprise a combination of devices that constitute the machine and may also include one or more steps of the functions that performed by the machine (e.g., R.A.C.C. Indus. v. Stun-Tech, Inc., 178 F.3d 1309 (Fed. Cir. 1998)(unpublished) (see Patent Subject matter Eligibility MPEP §2106). As such, the above-mentioned limitations do not further limit the apparatus in its *structure or functionality performed by the apparatus*. In accordance with the MPEP, the subject matter of a properly construed claim is defined by the terms that limit its scope. It is *this* subject matter that must be examined. Language that suggests or makes optional but does *not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation*. Examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use, (B) “*adapted to*” or “*adapted for*” clauses. See also MPEP § Patent Subject matter Eligibility 2106 and §2111.04.

5. Claim 117 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

#### ***Claim Rejection under 35 U.S.C. 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 117 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement including NEW MATTER. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In this case, the written description of the invention is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and §1302.01. The specification as filed has been reviewed and no written description of the claimed terms “management unit”, “determination unit”, “reception unit” and “generation unit” has been found. An applicant is entitled to be his or her own lexicographer. Namely, an inventor may define specific terms used to describe invention, but must do so “*with reasonable clarity, deliberateness, and precision*” and, if done, must “set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change” in meaning (see MPEP 2111.01(III)).

37 CFR 1.75 Claims: (1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims *must* find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See § 1.58(a), see MPEP 608.01(i))

The specification as filed has been reviewed and no written description of the claimed terms “management unit”, “determination unit”, “reception unit” and “generation unit” has been found. The claim 117 as filed fails to comply with the provision of 37 CFR 1.75. and fail to comply with the written description requirement including NEW MATTER.

5. Claim 117 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Claim Objection under 35 CFR 1.126***

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest

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numbered claims previously presented (whether entered or not). Misnumbered claim 123 on page has been renumbered as 124.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Thursday from 5:30 to 2:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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May 5, 2007

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